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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/840,065

05/06/2004

Frank Ridel JR.

4429

6653

7590

11/16/2006

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EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3781

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/840,065

Applicant(s)

RIDEL, FRANK

Examiner

Anthony D. Stashick

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3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farhad 5,732,481 in view of Vassar 3,124,887 and Cohen 4,187,621. Farhad '481 discloses an adjustable height insole insert system with the width of the system being greatest at the point where the upper front heel portion and upper foot portion meet (see Figure 2). The sides of the insert tapers in both the heel and foot portion (also Figure 2, both in front of and behind transition line 32). Farhad '481 does not disclose the other limitations of the claims. Vassar '887 discloses the following: an insole 4 for shoes for height re-orientation; the removable insert 4 having a tapered foot engagement upper surface 5, oppositely disposed depending sidewall surfaces (see Figures 2 and 3) and an arcuate back heel surface (see Figures 2 and 3); a flat bottom portion 7 and a tapered bottom heel portion (located under 6 in Figure 3); the side surfaces defining an area of maximum transverse dimension there between in spaced relation to the arcuate heel surface (see Figure 2); the side surface contoured laterally with a tapered foot portion and correspondingly tapered rear portion (see Figure 2); the tapered upper foot engagement surface and the tapered bottom heel portion are in parallel spaced relation to one another (see Figure 3, the top surface and tapered bottom surface just under 6 are parallel); the area of maximum transverse dimension defines an upper foot engagement surface front portion of a known upper surface area less than that of a remaining upper surface area (see Figure 2); the insert is of a dimension for insertion into a shoe (see Figure 1); the tapered foot engagement surface provides an angular increasing surface height from the front to the back terminating at the arcuate back heel surface (See Figures 1-3); the transition from the

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bottom flat surface to the tapered bottom heel portion is longitudinally inward of the arcuate back heel surface junction therewith and with the junction of the tapered foot engagement upper surface (see Figure 2, tapers in arch area). Vassar '887 does not specifically disclose the material makeup of the insert. Cohen '621 teaches that an insert used inside a shoe to support a user's foot can be made of a closed cell cross-linked polyethylene allowing it to be tough and abrasion resistant yet flexible. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the insert of Farhad '481 with the dimensions of Vassar '887 to better fit the dimensions of the user's foot and to provide comfort and impact resistance. Furthermore, it would have been obvious to make the combination of Farhad '481 and Vassar '887 out of closed cell cross-linked polyethylene, as taught by Cohen '621, to make it more tough, abrasion resistant and still allow for flexibility of the insert. With respect to the limitation that the insert be monolithic, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v, Detroit Stove Works, 150 U.S. 164 (1893); see also In re Heinrich, 268 F.2d 753, 756, 122 USPQ 388, 390 (CCPA 1959). Regarding the limitation that the composition have an initial yield then be supportive, this is a typical function of polyethylene foam as it first yields under pressure then supports the user's foot.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Hills Des. 25,242. The references as applied to claim 1 above disclose all the limitations of the claim except the insert being a monolithic mass and sculptured into the shaped configuration. Hills '242 shows that an insert for insertion into a heel of a shoe can be a monolithic mass (i.e. made of one piece of one material). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the insert of the references as applied to claim 1 above out of a single piece of a single material, as shown by Hills '242, to make it more sturdy and avoid any separation of layers that might occur due to temperature and humidity. With respect to the insert

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being sculpted, it appears that this would make the claim a product-by-process claim and since a product is claimed and a similar product is found, it is not necessary to find it made by the same process, i.e. sculpted and shaped.

### ***Response to Arguments***

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The applicant's arguments have been addressed in the rejection set forth above.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

5. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how

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the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D. Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony D Stashick  
SPE  
Art Unit 3781

ADS